

Appl. No. 09/448,378
Amtd. dated April 22, 2004
Response to OA of November 5, 2003

3. Remarks

Applicants wish to thank the Examiner for his patience and guidance in this case. Claims 6, 7, 20 and 22-53 are currently pending in the application with claims 6 and 20 being in independent form. Claims 1-5, 8-19 and 21 have been previously cancelled without prejudice. Claims 54-56 have been withdrawn as being drawn to a non-elected invention. Applicants wish to withdraw claims 25 and 34.

Claims 27-30 and 36-39 have been amended to replace the transitional phrase "has" with "comprises." Applicants have always held that the phrase "has" carries the same interpretation as "comprising," as permitted by several Federal Circuit decisions, but, for the sake of clarity and to avoid any potential misinterpretation of the scope of the claims, Applicants wish to use the conventional phrase "comprising."

Applicants acknowledge that the effective filing date of the present claims is deemed to be the filing date of the priority application USSN 08/539,142, filed 10/4/95.

1. 35 U.S.C. §112, first paragraph

Claims 25 and 34 stand rejected under 35 U.S.C. §112, first paragraph. Applicants have elected to withdraw claims 25 and 34 from prosecution without prejudice and reserve the right to prosecute the claims in future applications.

2. 35 U.S.C. §103(a)

Claims 6, 7, 20 and 22-53 stand rejected as being unpatentable under 35 U.S.C. §103(a)/§102(e) over Lyman, et al. (USPN 5,843,423) in view of Elliott, et al. (USPN 5,478,556), Srivastava, et al. (USPN 6,017,544) and Brem, et al. (USPN 5,626,862). Applicants respectfully traverse.

A CPA was filed under 37 CFR §1.53(d) on June 28, 2001, which entitles the present application to enjoy the benefit of revised 35 USC §103(c). This provision precludes the use of commonly owned U.S. patents as prior art under §103(a)/§102(e) (see, MPEP 706.02(I)(1) at 700-50). In support of Applicants' claim of common ownership between the present application and Lyman, et al. (USPN 5,843,423), a Statement by Applicants' representative of record is included with this response (see, MPEP 706.02(I)(2)(II) at 700-53, *et seq.*). Because the primary reference has been disqualified, the rejection under §103(a)/§102(e) may be properly removed.

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Applicants note that the PCT International Application WO 94/28391 from the patent family that spawned Lyman, et al. (USPN 5,843,423), has a publication date of December 8, 1994. This publication date is less than a year from the present application's earliest effective filing date of October 4, 1995 and therefore the published PCT application does not qualify as prior art under 102(b).

Applicants note that the main independent generic claims (claims 6 and 20) are free from the cited art and are ostensibly allowable. Therefore, any claims dependent therefrom, are also deemed allowable (see, MPEP 806.04(d) at 700-41).

Applicants kindly request allowance of the pending claims as amended. If the Examiner believes that any issues could be addressed by way of a telephone conference, the Examiner is cordially invited to telephone the undersigned.

Respectfully submitted,



James K Janiecki
Attorney for Applicants
Reg. No. 38,207

Immunex Corporation
Law Department
1201 Amgen Court West
Seattle, WA 98119-3105
Telephone (206) 265-7000

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below.

Signed: 
Nanci M. Kertson

Date: April 22, 2004